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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,926	02/06/2004	Howard Morgenstern	34298	8861

7590 10/18/2005

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EXAMINER

PAREKH, NITIN

ART UNIT	PAPER NUMBER
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2811

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/774,926

Applicant(s)

MORGENSTERN ET AL.

Examiner

Nitin Parekh

Art Unit

2811

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02-26-04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 6 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- A. Limitations as recited in claims 1, 6 and 11 include "wherein the walls and the top are each made of a continuous piece of material".

However, the specification (see pp. 3, lines 24-34) describes the walls and top being made of a single piece structure. There is no description in the specification where the walls and the top each being made of a continuous piece of material.

3. Claims 1, 6 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the invention.

A. Limitations as recited in claims 1, 6 and 11 include “wherein the walls and the top are each made of a continuous piece of material”.

However, the specification (see pp. 3, lines 24-34) describes the walls and top being made of a single piece structure. There is no description in the specification how the walls and the top each are being made of a continuous piece of material.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3 and 6-8, insofar as being in compliance with 35 U.S.C. 112, are rejected under 35 U.S.C. 102(b) as being anticipated by Zhou (US Pat. Application Pub. 2002/0005574).

Regarding claims 1-3 and 6-8, Zhou discloses a cover/enclosure for hermetically sealing an electronic package/microsystem (see 400 and 300 respectively in Fig. 5), the cover/enclosure comprising:

- a substrate (312/302 in Fig. 5) whereupon the electronic package/microsystem is located
- a single piece/rigid lid/cover (see 400 in Fig. 5) including walls, a top and a cavity (see 400 in Fig. 5; sections 0047-0050)
- a single solder/solder perform (not numerically referenced in Fig. 5) interposed directly between the single piece/rigid lid/cover and the substrate in order to facilitate creating a hermetically sealed cavity defined by the single piece/rigid lid/cover and the substrate for enclosing the microsystem, solder/solder perform including a conventional gold-tin solder (section 0054).

(Fig. 5; sections 0045-0054).

Zhou further discloses single piece/rigid lid/cover having a gold plating over a nickel plating, the thickness of the platings being approximately in a range of 0.000050-0.00015 inches (see section 0047).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4, 5 and 9-11, insofar as being in compliance with 35 U.S.C. 112, are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhou (US Pat. Application Pub. 2002/0005574) in view of Stark (US Pat. 6759590) and Leung et al. (US Pat. 6661090).

Regarding claims 4, 5 and 9-11, Zhou teach substantially the entire claimed structure as applied to claims 1-3 and 6-8 above, except the solder perform having a thickness of thickness of approximately 0.003 inches and a composition of approximately 80% gold and 20% tin respectively.

Stark et al. teaches a hermetically sealing electronic package/microsystem (102/302 in Fig. 1-3 and 11) using an eutectic gold-tin solder wherein the solder layer has a thickness in a range of 6 microns/0.002 inches- 101 microns (about 0.04 inches- see Col. 29, lines 20-49).

Leung et al. teach a sealing a lid to a substrate of an electronic package with a gold-tin solder having a composition including 80% gold and 20% tin (see 430 in Fig. 4d Col. 3, line 51- Col. 4, line 30).

It would have been obvious to a person of ordinary skill in the art at the time invention was made to incorporate the solder perform having a thickness of thickness of

approximately 0.003 inches and a composition of approximately 80% gold and 20% tin respectively as taught by Stark and Leung et al. so that the bonding, adhesion and reliability can be improved in the Zhou's enclosure.

Response to Arguments

8. Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nitin Parekh whose telephone number is 571-272-1663. The examiner can normally be reached on 09:00AM-05:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Steven Loke can be reached on 571-272-1657.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAN or Public PAG. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAG system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

NP

10-16-05



NITIN PAREKH

PRIMARY EXAMINER

TECHNOLOGY CENTER 2800